

REMARKS

Forty-five claims are pending in the present Application. Claims 1-45 currently stand rejected. Claims 1, 4-5, 10, 21, 24-25, 30 and 41 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

Rejection under 35 U.S.C. §112, Second Paragraph

On page 3 of the Office Action, the Examiner indicates that claims 5, 25, and 41 are rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Accordingly, claims 5, 25, and 41 are amended to delete the limitation “economically”. In view of the foregoing remarks and amendments, Applicants believe that the Examiner’s rejections are addressed, and respectfully requests that the rejections under 35 U.S.C. §112, second paragraph, be withdrawn so that claims 5, 25, and 41 may issue in a timely manner.

35 U.S.C. § 102(e)

On page 4 of the Office Action, the Examiner rejects claims 1-3, 21-23, 43, and 45 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,701,058 to Tsubaki (hereafter Tsubaki). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.”

Diversitech Corp. v. Century Steps, Inc., 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Tsubaki fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner's rejection of independent claims 1 and 21, Applicants respond to the Examiner's §102 rejection as if applied to amended independent claims 1 and 21. For example, amended independent claim 1 now recites "*said imaging device associating a user identifier with said data; a data destination configured to receive said data and said user identifier from said imaging device for subsequent access by a system user, said data destination categorizing said data by referencing said user identifier,*" which are limitations that are not taught or suggested either by the cited reference, or by the Examiner's citations thereto.

Tsubaki teaches a camera that uploads images to a recorder device whenever remaining storage space in the camera is less than required for a designated number of additional images. Tsubaki refers to the foregoing remaining storage space as "residual capacity" (see column 2, lines 7-10). Tsubaki therefore compares the "residual capacity" to a predetermined threshold. In addition, Tsubaki triggers an upload to the recorder device only if the residual capacity "becomes less than a predetermined threshold" (column 2, lines 7-10).

In contrast, Applicants upload image data to a data destination when "said data stored in said data buffers exceeds a predetermined threshold amount" (see claim 1). Applicants therefore compare "data stored" to a predetermined threshold. In addition, Applicants trigger an upload to the data destination when

the data stored “exceeds a predetermined threshold amount”. Tsubaki therefore monitors a different parameter (“residual capacity” versus “data stored”) for triggering uploads. In addition, Tsubaki utilizes different criteria with respect to the monitored parameter for triggering an upload (“less than” versus “exceeds”). Applicants therefore submit that Tsubaki fails to identically teach Applicants’ claimed invention.

In addition, as discussed above, Applicants submit that Tsubaki nowhere teaches “said imaging device associating a user identifier with said data” and “said data destination categorizing said data by referencing said user identifier.” For at least the foregoing reasons, Applicants therefore submit that independent claims 1 and 21 are not anticipated by the teachings of Tsubaki.

With regard to claim 45, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 as discussed above. Applicants therefore incorporate those remarks by reference with regard to claim 45. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 45, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of Tsubaki and Applicants’ invention as disclosed in the Specification, claim 45 is therefore not anticipated or made obvious by the teachings of Tsubaki.

Regarding the Examiner's rejection of dependent claims 2-3, 22-23, and 43, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested.

Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Tsubaki to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of claims 1-3, 21-23, 43, and 45, so that these claims may issue in a timely manner.

35 U.S.C. § 103

On page 5 of the Office Action, the Examiner rejects claims 4, 24, and 42 under 35 U.S.C. § 103 as being unpatentable over Tsubaki in view of U.S. Patent No. 6,393,470 to Kanevsky et al. (hereafter Kanevsky). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine

reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 4, 24, and 42, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 4, 24, and 42, so that these claims may issue in a timely manner.

In addition, on page 5 of the Office Action, the Examiner concedes that Tsubaki fails to disclose that "an information source provides identification information" Applicants concur. The Examiner then points to Kanevsky to purported remedy these deficiencies. Kanevsky teaches a network of servers that monitor portable electronic devices until one of the servers "detects that some embedded computer, e.g. (video) camera, is near full" (see column , lines 14-15). In Kanevsky, when a server detects that a camera is nearly full of image data, then "this server moves stored images to a storage server" (see column 2, lines 27-28). Kanevsky therefore discloses a "pull" operation in which an

external server network monitors portable devices, and actively pulls the image data from the portable devices.

In contrast, independent claims 1 and 21 affirmatively recite “a transfer manager of said imaging device for transferring said data from said imaging device to said data destination.” Unlike Kanevsky, Applicants’ explicitly recite the transfer manager of the imaging device “*monitoring said data buffers, and automatically transferring said data if said data stored in said data buffers exceeds a predetermined threshold amount.*” Applicants thus disclose and claim a “push” operation in which the imaging device monitors its own memory storage level, and actively pushes the image data to a specified destination.

For at least the foregoing reasons, Applicants therefore submit that Kanevsky teaches away from Applicants’ invention. A prior art reference which teaches away from the presently claimed invention is “strong evidence of nonobviousness.” In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed.Cir. 1987).

In addition, Applicants submit that neither of the cited references teach “identification information including said user identifier for identifying said imaging device and a destination identifier for identifying said data destination,” as claimed by Applicants in amended claims 4 and 24. For at least the foregoing reasons, the Applicants submit that claims 4, 24, and 42 are not unpatentable under 35 U.S.C. § 103 over Tsubaki in view of Kanevsky, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully

request reconsideration and withdrawal of the rejections of claims 4, 24, and 42 under 35 U.S.C. § 103.

On page 6 of the Office Action, the Examiner rejects claims 5 and 25 under 35 U.S.C. § 103 as being unpatentable over Tsubaki in view of Kanevsky, and further in view of U.S. Patent No. 6,393,470 to Tanaka et al. (hereafter Tanaka). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 5 and 25, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 5 and 25, so that these claims may issue in a timely manner.

In addition, with regard to the rejections of claims 5, 25, and 41, the Examiner concedes that “ neither Tsubaki nor Kanevski (sic) expressly discloses said data buffers being economically implemented.” Applicants concur. The Examiner then points to Tanaka to purported remedy these deficiencies by stating that “the cost of solid state memory increases almost linearly with its storage capacity.” The Examiner then concludes that “[i]t would have been obvious . . . to limit the storage capacity within a camera”

Applicants respectfully submit that a *general restatement of the advantages disclosed by the Applicants* deriving from implementation of the present invention may not act as the required teaching or suggestion to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that “it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants’ structure as a template and selecting elements from references to fill in the gaps.” In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

For at least the foregoing reasons, the Applicants submit that claims 5 and 25 are not unpatentable under 35 U.S.C. § 103 over Tsubaki and Kanevsky in view of Tanaka, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 5 and 25 under 35 U.S.C. § 103.

On page 8 of the Office Action, the Examiner rejects claims 6-10, 12, 15, 17-20, 26-30, 32, and 37-40 under 35 U.S.C. § 103 as being unpatentable over

Tsubaki, Kanevsky, and Kanevsky, and further in view of U.S. Patent No. 6,522,352 to Strandwitz et al. (hereafter Strandwitz). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of Tsubaki, Kanevsky, and Tanaka according to the teachings of Strandwitz would produce the claimed invention. Applicants submit that Tsubaki, Kanevsky, and Tanaka in combination with Strandwitz fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Tsubaki, Kanevsky, Tanaka nor Strandwitz contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of dependent claims 6-10, 12, 15, 17-20, 26-30, 32, and 37-40, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective

independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 6-10, 12, 15, 17-20, 26-30, 32, and 37-40, so that these claims may issue in a timely manner.

In addition, with regard to claims 15 and 35, Applicants submit that neither Tsubaki, Kanevsky, Tanaka nor Strandwitz teach that “a controller of said data destination sends an error message to said imaging device by said wireless communications network after determining that said data and said identification information have not been successfully received, said transfer manager responsively repeating said data transfer procedure to retransmit said data from said data buffers to said data destination”, as recited by Applicants in claims 15 and 35.

Furthermore, with regard to claims 10 and 30, Applicants submit that the cited references nowhere teach or disclose providing status information regarding at least one of said data transfer procedure and said arbitration procedure by using a user interface . . . ,” as recited by Applicants in claims 10 and 30.

For at least the foregoing reasons, the Applicants submit that claims 6-10, 12, 15, 17-20, 26-30, 32 and 37-40 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 6-10, 12, 15, 17-20, 26-30, 32, and 37-40 under 35 U.S.C. § 103.

On page 12 of the Office Action, the Examiner rejects claims 11 and 31 under 35 U.S.C. § 103 as being unpatentable over Tsubaki, Kanevsky, Tanaka, and Strandwitz, and further in view of U.S. Patent No. 5,128,776 to Scorse et al. (hereafter Scorse). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 11 and 31, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 11 and 31, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 11 and 31 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants

therefore respectfully request reconsideration and withdrawal of the rejections of claims 11 and 31 under 35 U.S.C. § 103.

On page 13 of the Office Action, the Examiner rejects claims 13, 14, 16, and 33-36 under 35 U.S.C. § 103 as being unpatentable over Tsubaki, Kanevsky, Tanaka, and Strandwitz, and further in view of U.S. Patent No. 6,058,304 to Callaghan et al. (hereafter Callaghan). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 13, 14, 16, and 33-36, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 13, 14, 16, and 33-36, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 13, 14, 16, and 33-36 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 13, 14, 16, and 33-36 under 35 U.S.C. § 103.

On page 17 of the Office Action, the Examiner rejects claim 41 under 35 U.S.C. § 103 as being unpatentable over Tsubaki and Kanevsky, with “a supporting reference of the Applicant’s Description of the Background Art” (hereafter ADBA). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner’s rejection of dependent claim 41, for at least the reasons that this claim is dependent from a respective independent claim whose limitations are not identically taught or suggested, the limitations of this dependent claim, when viewed through or in combination with the limitations of the respective independent claim, are also not identically taught or suggested.

Applicants therefore respectfully request reconsideration and allowance of dependent claim 41, so that this claim may issue in a timely manner.

In addition, the Examiner concedes that “Tsubaki and Kanevski (sic) are silent as to the imaging device being economically implemented without removable storage media capabilities.” Applicants concur. The Examiner then cites ADBA to purportedly remedy the foregoing deficiencies, stating that it is “well known within the art, that the inclusion of removable storage media capabilities . . . may result in a corresponding detrimental economic impact”

Applicants respectfully submit that their unique solution of the problems alluded to in ADBA indicates the clear existence of secondary indicia of non-obviousness. For example, there apparently has been a long-felt need for Applicants’ solution in the relevant technological field. Furthermore, other entities and individuals in analogous arts have apparently failed to successfully overcome the foregoing problems in the manner disclosed by Applicants.

For at least the foregoing reasons, the Applicants submit that claim 41 is not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 is thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 41 under 35 U.S.C. § 103.

On page 18 of the Office Action, the Examiner rejects claim 44 under 35 U.S.C. § 103 as being unpatentable over Tsubaki in view of Examiner’s Official

Notice. The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants submit that it would not have been obvious to a person of ordinary skill the art at the time of the invention to develop the claimed invention. Applicants therefore respectfully request the Examiner to cite specific references in support of the Official Notice, and failing to do so, to reconsider and withdraw the rejections of claim 44, so that the present Application may issue in a timely manner.

Furthermore, the Court of Appeals for the Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicants submit that there is no teaching of a combination that would result in Applicant's invention, and therefore the obviousness rejection under 35 U.S.C §103 is not proper.

Applicants submit that the cited references, in combination with the Official Notice, do not suggest a combination that would result in Applicants' invention,

and therefore the obviousness rejections under 35 U.S.C §103 are improper. Applicants therefore respectfully request the Examiner to cite references in support of the Official Notice, and to also indicate where an explicit teaching to combine the cited references may be found.

For at least the foregoing reasons, the Applicants submit that claim 44 is not unpatentable under 35 U.S.C. § 103 over the cited reference, and that the rejection under 35 U.S.C. § 103 is thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 44 under 35 U.S.C. § 103.

Examiner Interview Summary

On February 9, 2006, Applicants' representative, Gregory Koerner, held an Examiner's Interview with Examiner Gary Vieaux to discuss various differences between the cited references and Applicants' claimed invention. Applicants argued that Tsubaki monitors a different transfer parameter ("residual capacity" versus "data stored") for triggering uploads. In addition, Applicants argued that Tsubaki utilizes different criteria with respect to the monitored parameter for triggering an upload ("less than" versus "exceeds"). Applicants further argued that Tsubaki nowhere teaches an imaging device associating a user identifier with image data, and a data destination categorizing the image data by referencing the user identifier.

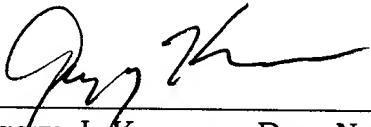
Summary

Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections. Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-45 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

Date: 2/11/06

By: _____


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